

Docket No. F-7030

Ser. No. 09/879,597

REMARKS

Claims 1-10 are now in this application. Claims 1-6 are rejected. Claims 1 and 3 are amended herein to clarify the invention, and to address matters of form unrelated to substantive patentability issues. New claims 7-10 are added.

Claim 1 is rejected under 35 U.S.C. §102(b) as being anticipated by the prior art disclosed in the specification and Fig. 4, the "Admitted Prior Art." Applicant herein respectfully traverses these rejections. "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). It is respectfully submitted that the cited reference is deficient with regard to the following.

It is respectfully submitted that the Examiner has misinterpreted the art of Fig. 4. The art of Fig. 4 shows a single particle detector and not a plurality. The Examiner's statement that "it is inherent to use more than one to make a plurality and more specific measurements in the medium" is without legal basis in the art cited. There is no teaching to use more than one particle detector besides that provided by the applicant's own specification describing the present invention.

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Since the features of the above referenced claim are not specifically disclosed, the reference must be sufficient to support an inherent disclosure of the subject matter. In *In re Rijckaert*, 28 USPQ2d 1955 (CAFC 1993) the Examiner relied upon inherency to provide for various features of a rejected claim which were not explicitly stated or implied in the reference. The Court of Appeals of the Federal Circuit stated that:

"The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient [to establish inherency.]" *In re Oelrich*, 666 F.2d 578# 581-82, 212 USPQ 323, 326 (CCPA 1981) (citations omitted) (emphasis added). "That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966). Such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. See *In re Newell*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The concept that a reference inherently discloses material anticipating a claimed invention may not be relied upon where the consequences of following the reference disclosure does not always inherently produce the results of the claimed invention. *W.L. Gore Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 314 (Fed. Cir. 1983). In the present situation, there is nothing in the prior art that would lead one to use more than one particle detector. In the present situation, the multiple detector ports allow localization of a source of contamination which is not taught

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nor possible using the single detector. Claim 1 clearly recites that the detectors are fixed at dispersed positions in the base plate.

Still further, the cited art fails to teach fixing the detectors in a base plate. As stated in the specification with reference to Fig. 4, "a probe is inserted into the casing 10 through a door 10a for measuring the cleanliness inside the casing." No mention is made of fixing a plurality of probes in a base.

Claim 1 particularly describes and distinctly claims at least one element not disclosed in the cited reference. Therefore, reconsideration of the rejection of claim 1 and its allowance are respectfully requested.

Claims 2 and 5 are rejected under 35 U.S.C. §103(a) as obvious over the Fig. 4 art. Applicant respectfully traverses this rejection. As discussed above, there is nothing in Fig. 4 which would suggest using multiple detectors placed near the members. This feature allows localization of particle sources which is not suggested by the art. The art merely addresses testing the atmosphere in general and does not suggest contamination may be localized.

Claims 3-6 are rejected under 35 U.S.C. §103(a) as obvious over the Fig. 4 art in view of the Sugimoto reference. The Sugimoto reference provides no more relevant teachings than the Fig. 4 art. The Sugimoto reference merely details features of a particle counter and that the counter can verify the dust particle count

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when the pressure gradient is disturbed. Claim 5 is clearly distinguishable for reciting the plurality of measurement devices.

Furthermore, the art fails to teach the method feature recited in claims 7 and 8 which includes correlating measurements to periodic operations of the members. This is clearly distinguished from detecting a variance in particle count over a time period.

Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited reference(s) for the reasons stated above. Reconsideration of the rejections of claims 2-6 and their allowance are respectfully requested.

Applicant respectfully requests a one month extension of time for responding to the Office Action. Please charge the fee of \$110.00 for the extension of time to Deposit Account No. 10-1250.

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In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited. Please charge any deficiency or credit any overpayment to Deposit Account No. 10-1250.

Respectfully submitted,
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